

REMARKS

Claims 10-17 are pending. By this Amendment, claims 10, 11, 13, and 14 are amended, and claims 16 and 17 are canceled.

Applicant notes that the Office Action of May 9, 2001, included an Interview Summary relating to a telephone interview on April 27, 2001, between Examiner Solak and Applicant's previous attorney of record, Mr. James Nilles. The Summary indicates that claims 1-10 were discussed and that Mr. Nilles indicated that he would fax a preliminary amendment to the Examiner. Applicant notes that only claims 1-9 were pending at the time of the interview, and that a Preliminary Amendment was subsequently filed by Mr. Nilles on April 30, 2001, in which claims 1-9 were canceled and new claims 10-17 were added. The undersigned now has primary responsibility for this file.

The Office Action Summary of the Office Action mailed May 9, 2001, stated that claims 1-9 were withdrawn from consideration. Claims 1-9 were previously canceled by the Applicant in the Preliminary Amendment filed April 30, 2001.

Applicant notes that the drawings filed with the application are considered informal. Formal drawings will be filed pending allowance of the application.

The specification was objected to for various informalities. Appropriate correction has herein been made.

Claims 11, 12, 14, and 15 stand rejected under 35 U.S.C. § 101 for the stated reason of combining apparatus limitations into the steps of a method claim. This rejection is respectfully traversed. Each of claims 11, 12, 14, and 15 is an apparatus claim that respectively depends from an apparatus claim, and none includes a verb or other method language to so comprise a method step. Applicant respectfully requests that the rejection of claims 11, 12, 14, and 15 under 35 U.S.C. § 101 be withdrawn.

Claims 10-15 stand rejected under 35 U.S.C. § 112, second paragraph, for the stated reason of being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 10-15 have been amended herein. In particular, claim 10 now recites first and second pressure receiving portions, the first pressure receiving portion loaded in the first direction by the inhalation pressure and the second pressure receiving portion loaded in a second direction towards the valve seat by the variable control pressure. Claim 13 now recites a discharge pressure port.

Claims 11, 12, 14, and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for presenting non-*bona fide* method claims. As set forth above, each of claims 11, 12, 14, and 15 is an apparatus claim that respectively depends from an apparatus claim, and none includes a verb or other method language to so comprise a method step. Applicant respectfully requests that this rejection of claims 11, 12, 14, and 15 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 10 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,932,843 to Itoigawa et al. (hereinafter the '843 patent) in view of U.S. Patent No. 5,588,807 to Kimura et al. (hereinafter the '807 patent). Insofar as the rejection applies to the amended claims, the rejection is respectfully traversed.

With respect to claims 10 and 13, there is no motivation, either intrinsically or extrinsically, to combine the cited references as suggested in the Office Action. Accordingly, no *prima facie* case of obviousness has been established.

Even if the cited references were to be so combined, the references would not meet the claims. Claims 10 and 13 respectively recite a piston actuated valve closure device unitarily formed at an end of the piston valve body, in cooperation with the other elements recited in each claim. Neither the '843 patent nor the '807 patent teach or suggest a piston

actuated valve closure device unitarily formed at an end of the piston valve body, in cooperation with the other elements respectively recited in claims 10 and 13.

The '843 patent does not teach or suggest that control valve member 403 is uniformly formed at an end of connecting member 413. The '807 patent does not teach or suggest that valve body 28 is uniformly formed at an end of actuation rod 33, rather that "actuation rod 33 is urged downward in a direction to move away from the valve body 28 . . ." Column 3, lines 60-61. The '807 patent also does not teach or suggest that valve body 47 is unitarily formed at an end of a piston valve body.

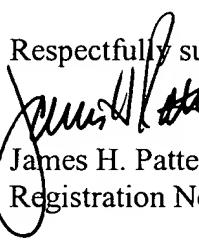
Therefore, claims 10 and 13 are allowable. Claims 11, 12, 14 and 15, although not treated in the art rejections, depend from claims 10 and 13 and are allowable at least for the reasons set forth above.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,145,326 to Kimura et al. (hereinafter the '326 patent) in view of the '807 patent. Claims 16 and 17 are herein canceled without prejudice.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


James H. Patterson
Registration No. 30,673

Customer No. 24113
Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5741